

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

INTELLECTUAL VENTURES I LLC AND
INTELLECTUAL VENTURES II LLC

Plaintiff,

v.

HSBC USA INC. AND HSBC BANK USA,
NATIONAL ASSOCIATION,

Defendants.

1:13-cv-5386-WHP AJP

**JOINT REPORT OF THE PARTIES PURSUANT
TO THE JULY 9, 2014 ORDER OF THIS COURT**

The parties jointly submit this report pursuant to the July 9, 2014 order of this Court. At a conference in this action on January 10, 2014, the parties and the Court agreed that it made sense to stay this action pending a decision of the Supreme Court of the United States in the action Alice Corporation Pty. Ltd. v. CLS Bank Int'l, No. 13-298. The Supreme Court issued its opinion in that action June 19, 2014. While the parties disagree as to how that opinion will impact the validity of the patents in suit, two other events have arisen that create the need for a continued stay of this action: (i) a judgment by the district court in the Eastern District of Virginia that two of the patents in suit are invalid, and (ii) the filing of requests for Covered Business Method Post Grant Review (“CBMPGR”) for each of the patents in suit.

In response to the January 13, 2014, order of the Court (Dkt. 55) staying this action and directing the parties to submit a status report by June 30, 2014, the parties submitted a

stipulation and proposed order further staying this action pending the latter of the final resolution of two events:

(1) The appeal filed May 13, 2014 in *Intellectual Ventures I LLC v. Capital One Financial, U.S. Court of Appeals for the Federal Circuit*, Case No. 14-1506, from the final judgment entered in Case No. 1:13cv740 in the Eastern District of Virginia, Alexandria Division, on April 22, 2014 (Doc. 376), and from the Order and Opinion granting summary judgment to Defendants in that action on April 16, 2014 (Doc. 371 & 372), and from all previous orders, rulings, findings, stipulations, and conclusions entered in that; and

(2) Final resolution of the last CBMPGR on any of the patents in suit, all of which are currently subject to CBMPGRs filed November 12, 2013 under CBM2014-0028 (PTAB) (Count 4 for infringement of U.S. Patent 8,083,137), CBM2014-0029 (PTAB), (Count 1 for infringement of U.S. Patent No. 7,664,701), CBM2014-0031 (PTAB), (Count 3 for infringement of U.S. Patent No. 6,182,894), CBM2014-0032 (PTAB), (Count 2 for infringement of U.S. Patent No. 7,603,382), and CBM2014-0033 (PTAB) (Count 5 for infringement of U.S. Patent No. 7,260,587). Note that Count 3 asserting of infringement of U.S. Patent No. 6,182,894 was previously dismissed by stipulation.

The parties therefore jointly request that the Court continue the stay in this action and

adjourn the conference scheduled for August 1, 2014, at 10:30 for about six months.

Dated: July 18, 2014

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